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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/788,261 02/19/01 KRULL

M 1997DE403C/C

025255 IM52/0821
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EXAMINER

MENLEY, M

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

08/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/788261

Applicant(s)

KRULL et al

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
 - ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The request filed on February 19, 2001 for a Continuation-In-Part Application (CIP) of prior application No. 09/115,548 is acceptable and a CIP has been established. An action on the CIP follows:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter of claim 7 that "the structural units (B1) and (B2) stated under (B) are selected from the group consisting of vinyl ethers, alkyl acrylate, alkyl methacrylates or higher olefins having at least 5 carbon atoms" and claim 8 that "the higher olefins are selected from the group consisting of hexene, 4-methyl pentane, octene and diisobutylene" is not properly described and consequently raise doubt as to possession of the claimed invention at the time of filing. It is noted that at page 9 of the instant application that the subject matter of claims 7-8 are directed to the further comonomers up to 5% by weight as an optional component under B), but not as B1) nor B2).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16 and 17 at line 2 contain the open-ended phrase "comprises" which is broader than the "consist essentially of" found in lines 7-8" of claim 1 and is indefinite and confusing.

Clarification is requested. It is suggested that applicants may use the phrase "consist of" in place of line 2 "comprises", and "copolymers" in place of "composition" in line 1 of claims 16 and 17 for clarity.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubishi Petrochemical Co. Ltd. EP 217,602 in view of Applicants Admission and Reimann et al (Reimann) 5,254,652.

Patentee '602 teaches and discloses fuel oil additives and fuel oil having improved flowability wherein the fuel oil is mineral oil note page 5 lines 9-21 and page 16 example B and the additives are one or more copolymers, note page 5 line 24 to page 7 lines 1-9. Patentee further teaches that the additives acts effectively on fuels having a B.P. range of 120°-500°C including not only fuels oils having a difference between the 20% distillation temperature and the 90% distillation temperature (D.T.) of at least 100°C. The additives improve both the flowability and plugging resistance of these oils, note page 5 lines 14-21.

It is noted at page 3 lines 23-27 that patentee discloses that there is very small difference between the temperature at which the precipitation of the crystals begins (the cloud point) and the temperature at which the crystals plug the filter or solidify (the cold filter plugging point or the pour point). It would be obvious to the skilled artisan in the art that the mineral oil of patentee having a pour point (PP) of -5°C, note page 16 Ex B, that the said oil inherently have a cloud point of less than -8°C.

Applicants instant claims differ from those of the prior art in that applicants claim recite a 95% distillation point of less than 350°C and require that the mineral oil have a sulfur contents of <500 ppm (claim 9) and < 300 ppm (claim 10) and <100 ppm (claim 11) and neoalkyl radical monomers. It is the Examiners position that mineral oils having 95% distillation point of less than

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350°C, and sulfur contents of < 500, <300 or <100 ppm would be obvious in the view of applicants admission and that neoalkyl radical monomers would be obvious in view of Reimann.

Applicants make admission on record at page 4 first paragraph of the instant application that conventional commercially available winter grades of diesel fuel have a cloud point of < -8°C, particularly < -15° C, very narrow distillation cuts B.P. ranges of 20 to 90% by volume < 120°C, in particulalyr < 100°C and in some cases < 80°C and in distillation volume of 95% by volume at temperatures < 360°C, particularly < 350°C and especially <330°C. It is further disclosed that diesel fuels having very low sulfur contents < 500 ppm and in particularly <100 ppm.

It would be obvious to the skilled artisan in the art to use the low sulfur diesel fuels and commercially available winter grade diesel fuels of the admitted prior art as the fuel oil of '602 with the reasonable expectation that its additives will impart both the flowability and plugging resistance of the oils because the additives have been shown to impart the same properties to narrow distillation cuts and broad cut distillation fuel oils.

Reimann teaches that mineral oil distillates flow properties can be improved with terpolymers containing neoalkyl radical monomers having melt viscosities at 140°C from 20 to 1000 M pas. s, note column 2 lines 33-68, column 4 lines 1-24 and Table 2. It would be obvious to the artisan in the art to substitute the neoalkyl radical monomer of Reimann for the ether or ester monomer of the primary reference with the reasonable expectation that the additive will impart its improved flow properties to the mineral oils.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No.

09/111,548. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed mineral oils and copolymers are obvious variants of the mineral oils and copolymers of related application No. 09/115,548 and they are not patentable distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 and 9-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/706,656. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed mineral oils and copolymers are obvious variants of the

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mineral oils and copolymers of related application No. 09/706,656 and they are not patentable distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art cited but not applied further teaches mineral oils and copolymers of the same nature as claimed by applicants.

Any inquiry concerning this communication should be directed to Margaret B. Medley at telephone number (703) 308-2518.

Margaret B. Medley /nh

August 7, 2001

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER